

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

REMARKS / ARGUMENTS

The present application includes pending claims 1-22, all of which have been rejected. By this Amendment, claims 1-2, 4-6, 8, 10, 12-17, and 19-20 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant points out that support for the new claim amendments may be found in the present application in, for example, paragraphs 31, 48, 53, 55, 60, 69-72, 78, and FIGS. 3-4 and 8-9.

The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1, 4-8, 10 and 12-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,659,366, issued to Kerman (“Kerman”), in view of U.S. Patent No. 7,150,031, issued to Rodriguez, et al. (“Rodriguez”). Claims 2, 3, 9, 11 and 19-22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kerman in view of Rodriguez, further in view of U.S. Patent No. 7,233,781, issued to Hunter, et al. (“Hunter”). The Applicant respectfully traverses these rejections at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference to do so*’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Kerman and Rodriguez Does Not Render Claims 1, 4-8, 10 and 12-18 Unpatentable

The Applicant now turns to the rejection of claims 1, 4-8, 10 and 12-18 as being unpatentable over Kerman in view of Rodriguez.

A. Independent Claims 1, 12 and 15

With regard to the rejection of independent claim 1 under 102(b), the Applicant submits that Kerman does not disclose or suggest at least the limitation of "the at least one communication device is operable to push at least a portion of the newly accessible media from the first geographic location to a second geographic location," as recited by the Applicant in independent claim 1.

The Applicant points out that Kerman discloses a notification system for television receivers, which operates by extracting and processing an information signal from the received television signal. See Kerman at col. 4, lines 33-36. In other words, Kerman generates a notification after the media content is accessed or received. Even though Kerman discloses generating of the notification after the media content is accessed or received, Kerman does not disclose that its notification system utilizes any media push capabilities relating to the newly accessible media content. Rodriguez does not overcome this deficiency of Kerman.

Therefore, the Applicant submits that Kerman does not disclose or suggest at least the limitation of "the at least one communication device is operable to push at least

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

a portion of the newly accessible media from the first geographic location to a second geographic location,” as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Kerman and is allowable. Independent claims 12 and 15 are similar in many respects to the system disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 12 and 15 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 4-8, 10, 13-14 and 16-18

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 12 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Kerman in view of Rodriguez has been overcome and requests that the rejection be withdrawn. Additionally, claims 4-8, 10, 13-14 and 16-18 depend from independent claims 1, 12 and 15, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 4-8, 10, 13-14 and 16-18.

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

II. The Proposed Combination of Kerman, Rodriguez and Hunter Does Not Render Claims 2, 3, 9, 11 and 19-22 Unpatentable

The Applicant now turns to the rejection of claims 2, 3, 9, 11 and 19-22 as being unpatentable over Kerman in view of Rodriguez and Hunter.

A. Rejection of Independent Claim 19

Independent claim 19 is similar in many respects to the system disclosed in independent claim 1. Therefore, the Applicant submits that independent claim 19 is also allowable over the reference cited in the Final Office Action at least for the reasons stated above with regard to claim 1. Additionally, since the additional cited reference (Hunter) does not overcome the deficiencies of Kerman and Rodriguez, claim 19 is also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 19.

B. Rejection of Dependent Claims 2, 3, 9, 11 and 20-22

Based on at least the foregoing, the Applicant believes the rejection of independent claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Kerman in view of Rodriguez has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Hunter) does not overcome the deficiencies of Kerman and Rodriguez, claims 2, 3, 9 and 11 depend from independent

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

claim 1, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1.

Based on at least the foregoing, the Applicant believes the rejection of independent claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Kerman in view of Rodriguez and Hunter has been overcome and requests that the rejection be withdrawn. Additionally, claims 20-22 depend from independent claim 19, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 3, 9, 11 and 20-22.

Application No. 10/675,090
Reply to Final Office Action of January 23, 2008

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-22 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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